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| EXAMINER |
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MANCHO, RONNIE M

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| ART UNIT | PAPER NUMBER |
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3663

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/30/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/774,301

Applicant(s)

IRISH ET AL.

Examiner

Ronnie Mancho

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 6-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-5 are not enabled. Applicant is claiming a structure, but applicants elected figure 1 and specification does not enable one skilled in the art to make and use the invention or ascertain the scope of the invention clear. As an example, the applicant's specification page 7, line 3 defines a cartridge as a collection of zones, items, events, etc. How does a collection of (zones, items, events, etc) store data? Applicant's elected fig. 1 does not disclose what applicant refers to as a cartridge which comprises a locational device and a processor as claimed. The claimed "cartridge" confuses the scope of the claims.

Applicant further recites "a user device executing the cartridge". Where is the user device that executes the cartridge?

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3663

4. Claims 1-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the applicant recites, “zone of influence”, or “zones of influence data”. One skilled in the art cannot ascertain what is being influenced with regard to the claimed “zones”, or does a zone of influence refer to a zone that has a mountain that influences peoples movement, flow of traffic, or a river that influences the economy of a region, etc? Since the claimed “zone of influence” cannot be ascertained, the scope of the rest of the limitations in the claims cannot be ascertained.

It is further not clear what all is meant by and encompassed by the limitations “a user device executing the cartridge comprising: a locational device self-identifying a location of the user device based on further geolocational data; and processor locally triggering at least one user event on the cartridge when the further geolocational data substantially correlates to the stored geolocational data for the zone of influence associated with the trigger condition of the at least one user event”. How does a user execute a cartridge wherein the cartridge is an object which comprises a locational device and a processor?

Applicant further recites “a cartridge storing data”, but applicant’s elected figure 1 show a database 15 storing cartridges.

Applicant further recites “locally triggered”. What is the meaning of “*locally*” in the claimed “locally triggered” as recited in the claims?

The rest of the claims are rejected for depending on independent claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sporgis (6320495).

Regarding claim 1, Sporgis (figs. 1-4) discloses a system for executing user navigational events (col. 3, lines 19-27) triggered through geolocational data (fig. 3), comprising:

a cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see specification, page 7, line 3) storing data, comprising:

zone of influence data defining one or more zones of influence and wherein each zone of influence is described by a plurality of stored geolocational data;

user event data defining one or more user events (i.e. individualized events; col. 3, lines 63-65, lines 19-26); and

event data associating one or more of the user events (i.e. individualized events; col. 3, lines 63-65, lines 19-26) with each zone of influence (col. 4, lines 14-15), wherein each user event specifies a trigger condition (col. 5, lines 4-9) based on the stored geolocational data (col. 5, lines 9-14) for the associated zone of influence; and

a user device executing the cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see specification, page 7, line 3) comprising:

a locational device 10 (col. 3, lines 1-18) self-identifying a location of the user

Art Unit: 3663

device based on further geolocational data (col. 5, lines 9-14); and

a processor locally triggering at least one user event (i.e. a new clue) on the cartridge when the further geolocational data substantially correlates to the stored geolocational data for the zone of influence associated with the trigger condition of the at least one user event (col. 5, lines 9-23).

Regarding claim 2, Sporgis (figs. 1-4) discloses the system according to claim 1, wherein the cartridge further stores data, comprising:

time event data specified by a start time and a duration associated with one or more of the user events with each timed events; and

the user device further comprising:

a timer measuring an elapsed time from the start time of each timed event, wherein the trigger triggers at least one user event when the elapsed time substantially equals the duration of one such timed event.

Regarding claim 3, Sporgis (figs. 1-4) discloses the system of claim 1, wherein the user event specifies one or more independent trigger conditions and associates one or more of the user events with each independent trigger condition, and the trigger triggers at least one user event upon satisfaction of at least one independent trigger condition, and the trigger at least one user-definable event upon satisfaction of at least one independent trigger condition

Regarding claim 4, Sporgis (figs. 1-4) discloses the system according to Claim 1, wherein the zone of influence data defines each zone of influence as discrete, adjoining, overlapping, and nested relative to at least one other zone of influence.

Art Unit: 3663

Regarding claim 5, Sporgis (figs. 1-4) discloses the system according to Claim 1, wherein the zone of influence data defines at least one zone of influence as inheriting at least one user event from one or more other of the other zones of influence.

MPEP 2114

2. The statements of intended use or field of use, "for executing", "triggered through", "defining one or more....", "associating one or more", "specifies a.....based on", "executing the", "locally triggering.....when", "correlates to.....for", "the cartridge defines", "associates", "triggerswhen.....equals", "triggers.....upon satisfaction of.....trigger condition", etc clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

The prior art anticipates the structure limitations in the claims and is capable of performing the intended use steps in the claims.

Response to Arguments

3. Applicant's arguments filed 11/16/06 have been fully considered but they are not persuasive.

The applicant argues that the IDS of March 21, 2003 has not been acknowledged. There is no IDS dated March 21, 2003 on record.

Applicant's arguments are drawn to limitations having 112 issues. Applicant's arguments are further drawn to method limitations in an apparatus claim. Claims 1-5 are apparatus claims, but applicant's elected figure 1 does not show the claimed structure of fig. 1.

Applicant argues that the prior art does not anticipate the claims. The examiner disagrees. The prior art anticipates the structure of the claims and is capable of performing the method steps therein.

In the arguments submitted 12-14-05, the applicant argues that the prior art does not teach "executing the cartridge". The examiner disagrees. The limitation is a method limitation in an apparatus claim. The prior art is capable of "executing the cartridge" since the prior art anticipates the structural limitations of the claims. It is believed that prior anticipates executing a cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see

Art Unit: 3663

specification, page 7, line 3) comprising identifying a location of the user device 10 based on further geolocational data (col. 5, lines 9-14). It is further noted that the limitation has a 112 rejection above.

Applicant further argues that the prior art does not anticipate “associating one or more user-definable events”, etc. The examiner disagrees. These limitations are just verbose and are all directed to MPEP 114 as pointed above. It is believed that the prior art anticipates “associating one or more user-definable events (i.e. individualized; col. 3, lines 63-65, lines 19-26) with each zone of influence (col. 4, lines 14-15), each user-definable event specifying a trigger condition (col. 5, lines 4-9) based on the stored geolocational data (col. 5, lines 9-14) for the associated zone of influence”.

The applicant further argues that the prior art does not anticipate “executing a user-definable event”. This limitation again is indefinite as pointed out above. It is not clear what limitations are included or not included in the claims. The applicant further argues that claim 1 provides non-linear events. In response, “non-linear events” was not in the claims.

See MPEP § 2114 states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531

The prior art discloses a system for executing user navigational events (col. 3, lines 19-27) triggered through geolocational data (fig. 3), comprising:

Art Unit: 3663

a cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see specification, page 7, line 3) storing data, comprising:

zone of influence data defining one or more zones of influence and wherein each zone of influence is described by a plurality of stored geolocational data;

user event data defining one or more user events (i.e. individualized events; col. 3, lines 63-65, lines 19-26); and

event data associating one or more of the user events (i.e. individualized events; col. 3, lines 63-65, lines 19-26) with each zone of influence (col. 4, lines 14-15), wherein each user event specifies a trigger condition (col. 5, lines 4-9) based on the stored geolocational data (col. 5, lines 9-14) for the associated zone of influence; and

a user device executing the cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see specification, page 7, line 3) comprising:

a locational device 10 (col. 3, lines 1-18) self-identifying a location of the user device based on further geolocational data (col. 5, lines 9-14); and

a processor locally triggering at least one user event (i.e. a new clue) on the cartridge when the further geolocational data substantially correlates to the stored geolocational data for the zone of influence associated with the trigger condition of the at least one user event (col. 5, lines 9-23).

Art Unit: 3663

The rejections are proper and thus stand.

Communication

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Examiner
Art Unit 3663


JACK KEITH
SUPERVISORY PATENT EXAMINER

3/29/07